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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,338	04/06/2006	Benjamin Fuest	3003-1078-1	9110
<div>466                      7590                      04/07/2009</div> <div>YOUNG &amp; THOMPSON</div> <div>209 Madison Street</div> <div>Suite 500</div> <div>ALEXANDRIA, VA 22314</div>				
EXAMINER				
REESE, DAVID C				
ART UNIT		PAPER NUMBER		
3677				
MAIL DATE		DELIVERY MODE		
04/07/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/533,338

**Applicant(s)**

FUEST, BENJAMIN

**Examiner**

David C. Reese

**Art Unit**

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

- Claims 14 and 16-17 were canceled.
- Claims 1-13 and 15 are pending.

### ***Claim Rejections - 35 USC § 112***

- [1] The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- [2] Claims 5 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 5, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Similarly, in claim 13, it can be either "some" or "all", it cannot be both.

### ***Claim Objections***

- [3] Claims 1 and 15 are objected to because of the following informalities: "a device for biasing" should be "biasing member" or something similar, as to be properly differentiated from the ultimate "device" of the invention (see preamble). Also note that depending claims 5-8 may need to be changed to reflect any amendment to the independent claims. Appropriate correction is required.
- [4] Claim 12 recites the limitation "the elongate member" in the instant claim. There is insufficient antecedent basis for this limitation in the claim since in depending claim 1 it is referred to as an elongate body.

Claim 13 recites the limitation "the components" in the instant claim. There is insufficient antecedent basis for this limitation in the claim and the depending one therefrom.

***Claim Rejections - 35 USC § 103***

[5] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[6] Claims 1-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgarten, US-640,357, in view of Perkins, US-316,650.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, Baumgarten teaches of a device (A) [for fixing an object to a tree]\*, the device (A) including:

an elongate body (A), one end (via a) of [which is adapted for attachment to a tree]\*, and a device (B) [for biasing an object slidably mounted on the elongate body towards the end of the body adapted for attachment to the tree]\*,

[in use, pressure resulting from growth of the tree being transmitted to the object and pushing it along the elongate body against the bias and away from the tree]\*.

\*Examiner's note: the above statements in brackets are examples of intended use. The prior art must only be capable of performing said functional recitations in order to be applicable. In the instant case, the elongate body of Baumgarten is indeed capable of being attached to a tree, etc. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The difference between the claim and Baumgarten is that Baumgarten does not expressly state of an object being slidably mounted on the elongate body. Perkins discloses a hook similar to that of Baumgarten including an elongate body (A), one end (via c) of which is adapted for attachment to a tree. In addition, Perkins further teaches of an object (i) mounted on the elongate body. It would have been obvious to one of ordinary skill in the art, having the disclosures of Baumgarten and Perkins before him at the time the invention was made, to modify the elongate body of Baumgarten to include an additional object or hook (i) placed after the biasing member towards the end of the body. One would have been motivated to make such a combination because such a configuration allows for the securement of another article to the device, as taught by Perkins.

Re: Claim 2, Baumgarten teaches wherein the elongate body (A) [is adapted for attachment to a tree]\* by being fitted with a fixing member (a).

Re: Claim 3, Baumgarten teaches wherein the fixing member (a) tapers to a sharp end point.

Re: Claim 4, Baumgarten teaches wherein the fixing member (a) is provided with a screw thread [for helping insert it into the tree and keep it in place]\*.

Re: Claim 5, Baumgarten teaches wherein the biasing device (B) applies pressure that is usually slightly lower than that pressure resulting from expansion of a growing tree, e.g. a pressure in the range of 7 - 8 kg/cm<sup>2</sup>.

Re: Claim 6, Baumgarten teaches wherein the biasing device (B) is formed of a resilient material.

Re: Claim 7, Baumgarten teaches wherein the biasing device (B) comprises a compression spring.

Re: Claim 8, Baumgarten in view of Perkins teaches wherein one end of the biasing device (B) abuts the object (I of Perkins).

Re: Claim 9, Baumgarten teaches further including a component (see right of spring in fig. 6 of Baumgarten), such as a washer or a ring, that is slidably mounted on the elongate body between the object and the tree so that the tree at least partially contacts the component, the component at least partially transmitting the pressure to the object.

Re: Claim 10, Baumgarten teaches wherein the length of the elongate body is adjustable.

Re: Claim 11, Baumgarten in view of Perkins teach wherein the elongate body (A) is comprised of a plurality of elongate members.

Re: Claim 12, Baumgarten in view of Perkins teach wherein the elongate member is generally cylindrical.

Re: Claim 13, Baumgarten in view of Perkins teach wherein some or all of the components forming the device are formed of plastics or metal material, such as stainless steel.

As for Claim 15, Baumgarten in view of Perkins teach of a device (A) [for fixing an object to a tree]\*, the device including:

an elongate body (A), one end (via a) of which [is adapted for attachment to a tree]\*; an object (I of Perkins) slidably mounted (to the right of the biasing member B) on the elongate body (A), and

a device (B) for biasing the object (I of Perkins) towards the end of the body [adapted for attachment to the tree]\*,

[in use, pressure resulting from growth of the tree being transmitted to the object and pushing it along the elongate body against the bias and away from the tree]\*.

### ***Conclusion***

[7] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited further to show the state of the art with respect to this particular type of fastener: please see submitted notice of reference cited.

[8] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached at (571) 272-6987. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese

/D. C. R./  
Examiner, Art Unit 3677

/Victor Batson/  
Supervisory Patent Examiner, Art Unit 3677